

### REMARKS-General

1. Upon review of the original specification and in light of the observation of the Examiner noted in the above Office Action, the applicant has amended the abstract and title of the specification which is deemed to more clearly and distinctly describe the subject matter of the instant invention, and which provides full antecedent basis to the newly drafted claims. No new matter has been included.

2. The newly drafted independent claim 21 incorporates all structural limitations of the original claim 1 and includes further limitations previously brought forth in the disclosure. No new matter has been included. All new claims 21 to 28 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

#### Response to Rejection of Claim 1 under Obviousness Double Patenting

3. The original claim 1 has been deleted in this application.

#### Response to Rejection of Claims 1-20 under 35USC102

4. Pursuant to 35 U.S.C. 102, "a person shall be entitled to a patent unless:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States."

5. In view of 35 U.S.C. 102(b), it is apparent that a person shall not be entitled to a patent when his or her invention was patent in this country more than one year prior to the date of the application for patent in the United States. However, the Tsuda patent and the Corsi et al patent and the instant invention are not the same invention according to the fact that neither the independent claim 1 of the Tsuda patent nor the independent claims 1 and 13 of the Corsi et al patent read upon the instant invention and the newly drafted independent claim 21 of the instant invention does not read upon the Tsuda and the Corsi et al patents too. Apparently, the instant invention as claimed in the newly drafted claim 21 should not be the same invention as the Tsuda patent and Corsi et al patent which both fail to anticipate the distinctive features including the holding slot which has an arc-shaped cross section and a size and curvature arranged

for the pivot arm to be pivotally received therein, so as to enable the case cover to be pivotally folded with respect to the case body between a closed position and an opened position, wherein in the closed position, the support portion of the pivot arm is slid out of the holding slot until the rear biasing surface of the pivot arm is biased against the closed stopping surface of the outer wall, and that in the opened position, the support portion of the pivot arm is slid into the holding slot until the front biasing surface of the pivot arm is biased against the opened stopping surface of the holding slot, wherein the support base has a top round end and is biased against the inner wall and functions as a pivot point of the second joint, wherein the inner wall is arranged to slidably move at the top round end of the support base between the opened position and the closed position, wherein the inner wall further has a flat positioning surface slidably biased against the top round end of the inner wall so as to enhance a folding operation of the case cover with respect to the case body.

6. Applicant believes that for all of the foregoing reasons, the claims 21 to 28 are in condition for allowance under 35USC102(b) in view of Tsuda and Corsi et al.

#### **Response to Rejection of Claims 1 to 20 under 35USC103**

7. The Examiner rejected claims 1 to 20 over Tsuda which teaches a hinge structure, but Tsuda fails to suggest the case as claimed in of claims 21 to 28 of the instant invention, including the following distinctive structural features:

(i) an elongated outer wall and an elongated inner wall, wherein the holding slot is defined between the elongated outer wall and the elongated inner wall, so as to define a **closed stopping surface** on the outer wall at an opening end of the holding slot and an **opened stopping surface** at a closed end thereof,

(ii) the elongated pivot arm of the second joint having an arc-shaped cross section and an elongated support portion integrally extended from the support base and an enlarged end portion that defines a **front biasing surface** provided at a front end of the end portion and a **rear biasing surface** outwardly extended between the support portion and the end portion,

(iii) the support portion of the pivot arm is slid out of the holding slot **until the rear biasing surface of the pivot arm is biased against the closed stopping**

**surface of the outer wall, and that in the opened position, the support portion of the pivot arm is slid into the holding slot until the front biasing surface of the pivot arm is biased against the opened stopping surface of the holding slot, and**

(iv) the support base having a top round end and is biased against the inner wall and functions as a pivot point of the second joint, wherein the inner wall is arranged to slidably move at the top round end of the support base between the opened position and the closed position, wherein the inner wall further has a flat positioning surface slidably biased against the top round end of the inner wall so as to enhance a folding operation of the case cover with respect to the case body.

8. The Examiner appears to reason that although Tsuda does not teach a case body and a case cover, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the hinge on a case comprising a case body and a case cover as an alternate use of the hinge for opening and closing a storage case. But this is clearly **not** a proper basis for combining references in making out an obviousness rejection of the present claims. Rather, the invention must be considered as a whole and there must be something in the reference that suggests the combination or the modification. See Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984) ("The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination"), In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") In re Laskowski, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.")

9. In addition, "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems

as the inventor and with no knowledge of the claimed invention, would select the elements from the cited art references for combination in the manner claimed... [T]he suggestion to combine requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness..." *In re Gorman*, 933 F.2d 982, 986, 18 USPQ 2d 1885, 1888 (Fed. Cir. 1991).

10. The Office Action fails to provide a reasoned analysis on why one of ordinary skilled in the art would have modified embodiments in the detailed description of the preferred embodiment of Tsuda. In the present case, there is no such suggestion. Tsuda performs a different type of hinge structure.

11. The applicant respectfully further submits that broad conclusory statements regarding the teaching of a reference is not evidence. There has to be actual evidence that is clear and particular. *Bard v. M3*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." See *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1476, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993). "The Examiner's conclusory statement that the specification does not teach the best mode of using the invention is unaccompanied by evidence or reasoning and is entirely inadequate to support the rejection." *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977).

12. The rejections in the Office Action are broad conclusory statements: The invention is obvious because they are considered as "an alternate use", the invention is not patentable. Such broad conclusory statements are not sufficient to support the rejection.

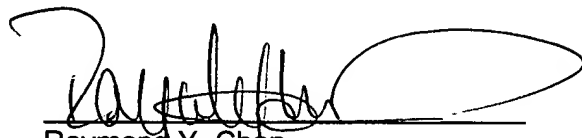
13. Applicant believes that for all of the foregoing reasons, the newly drafted claims 21 to 28 are in condition for allowance and such action is respectfully requested.

#### **The Cited but Non-Applied References**

14. The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

15. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the objection and rejection are requested. Allowance of claims 21 to 28 at an early date is solicited.

Respectfully submitted,




Raymond Y. Chan  
Reg. Nr.: 37,484  
108 N. Ynez Ave.  
Suite 128  
Monterey Park, CA 91754  
Tel.: 1-626-571-9812  
Fax.: 1-626-571-9813

#### CERTIFICATE OF MAILING

I hereby certify that this corresponding is being deposited with the United States Postal Service by First Class Mail, with sufficient postage, in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: January 12, 2004

Signature:   
Person Signing: Raymond Y. Chan